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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/897,656	06/29/2001	Alan C. Berkema	10016784-1	9732

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

POLTORAK, PIOTR

ART UNIT	PAPER NUMBER
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2134

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/23/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/897,656

Applicant(s)

BERKEMA ET AL.

Examiner

Peter Poltorak

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4,5,10-12,15,18-20,22,32-34 and 37-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4,5,10-12,15,18-20,22,32-34 and 37-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

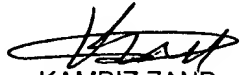
Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


KAMBIZ ZAND
PRIMARY EXAMINER

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. The Amendment, and remarks therein, received on 12/18/2006 have been entered and carefully considered.
2. The Declaration of Prior Invention under 37 C.F.R. 1.131 establishing conception of the subject matter of the present patent application in the United States prior to the earliest effective date of May 21, 2001 has been entered. As a result, the Nordman (U.S. Pub. 20020174364) reference does no longer qualifies as a valid reference under 35 U.S.C. 103(a). However, the new search has resulted in newly discovered prior art. New grounds of rejection based on the newly discovered prior art follow below.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.

Response to Amendment

4. Applicant's arguments have been carefully considered.
5. In light of applicant remarks, the language of claims 37-39 overcame the art of record.
6. As per claim 5, 18 and 37, applicant argues that Larsson and Woo does not teach a computer program product as claimed in the argued claims.

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7. Applicant's arguments have been carefully considered but were not found persuasive. Larsson in view of Woo discloses a wireless device (a cell phone) wirelessly communicating a reference identifying a location to a print device. A wireless device disclosed by Larsson is clearly an electronic device that, among other functionalities, is capable of communicating references to another devices and receive and transmit content to other devices. Furthermore, identifying and communicating with available communicating devices (e.g. 926-934 Fig. 11), processing retrieved information and forwarding the information to other devices (e.g. 932-936) are further the proof of dynamic functionality (thanks to a processor and memory, Fig. 6) of the device disclosed by Larsson in view of Woo. This clearly suggests that the device must operate using a computer code or using applicant's claim language "a computer program product".
8. As per claim 5 and 18 applicant further argues that "the document address is not communicated to "the print device", that "the print device does not supply the document address to "the print service", and that the print device does not retrieve the print content.
9. The examiner points to Fig. 1 and pg. 13 line 27-28 that clearly shows the print service (300 b) being embedded within the print device. As a result in order for the information (e.g. the document address) to reach print service the print device must first receive it. Similarly, the print service must utilize the print device in order to request and receive the print content. Finally, the document address received by the printer is accessed by the print service.

10. Claims 4-5, 10-12, 15, 18-20, 22, 32-34 and 37-45 have been examined.

Claim Rejections - 35 USC § 103

11. Claims 4, 19, 32-34, 40, 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeBry (U.S. Patent No. 6385728) in view of Bluetooth as evidenced by Naoaki (U.S. Pub. No. 20020076051).

As per claims 4, 19, 32-34, 44 DeBry discloses communicating a reference to a print device (print server 30), the reference (a will-call certificate) identifying a location at which a print content (requested document to be printed) is located on a network and the location of a print service (a document source 10), wherein the reference causes the print device to retrieve the print content from the network and to print the print content (Fig. 2 and 3, col. 5 lines 5-7, col. 6 lines 55-64, col. 7 lines 20-51 and col. 8 lines 6-36). Furthermore, DeBry discloses communicating a security access code (a digital signature) to the print device wherein the access code enables access to the print content (col. 7 line 15 – col. 8 line 36). Additionally, DeBry discloses a security access code (encrypted message) in response to a security challenge received from the print device used to restrict access to the print device (Fig. 4 and col. 9 lines 5-27).

12. As per storing and retrieving the reference from a memory of the computer, computer programs (computer readable code) facilitate operation of a computer, and computers use memory to process (store and retrieve) information when accessing,

receiving, sending and operating on data. As a result, DeBry's disclosure of a computer communicating a reference to a print device wherein the reference identifying a location at which a print content is located on a network and the location of a print service reads on the claim limitations.

13. As per claim 40, DeBry discloses the need for ability to control the number of copies being distributed, e.g., to protect copyright in the document and/or payment of a fee on a per-copy basis (col. 4 line 67 – col. 5 line 2) that results in a user paying a fee for the right of printing the print content (col. 7 lines 7-13). Furthermore, DeBry discloses the reference data comprises a serial number for tracking purposes (Fig. 2 and col. 7 lines 30-35). As a result it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to utilize a serial number as billing information given the benefit of uniquely identifying a transaction and enabling appropriate charge for the printed content.

14. DeBry does not teach that the communication is a wireless communication and does not receiving a responsive signal from a print device in response to a wirelessly communicated discovery signal for locating one or more print devices.

Bluetooth disclosed by Naoaki is a wireless communication, wherein a response signal from a device (such as a print device) to a discovery signal, wherein the response signal comprises a physical location of the responding device (Naoaki [65]). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to communicate a wireless discovery system to receive a responsive signal from a print device given the benefit of detect surrounding

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Bluetooth terminal to open communication channel for transferring data, for example (Naoaki [65]).

15. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over DeBry (U.S. Patent No. 6385728) in view of Bluetooth as evidenced by Naoaki (U.S. Pub. No. 20020076051) and further in view of Larsson (International Publication No. WO 0142894).

DeBry in view of Bluetooth discloses the print device responding to the discovery signal, as discussed above.

16. DeBry in view of Bluetooth does not disclose that a responsive signal identifies one or more of the print capabilities of the print device, the one or more of the print capabilities identifying a capability of the print device to print the print content. Larsson's discloses a print device sending a response signal identifying one or more of the print capabilities of the print device to print content (Larsson, pg. 14 lines 1-3, pg. 16 lines 25-27 and 21 lines 1-6).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to include indication of one or more of the print capabilities of the print device to print content in a response signal. One of ordinary skill in the art would have been motivated to perform such a modification so that the print device could receive jobs that is capable to print.

17. Claims 41 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeBry (U.S. Patent No. 6385728) in view of Bluetooth as evidenced by Naoaki (U.S. Pub. No. 20020076051) in view of Manglapus (U.S. Pub. No. 6219151).

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DeBry in view of Bluetooth disclose wirelessly communicating the reference to a print device as discussed above.

18. Debry in view of Bluetooth do not disclose that after communicating the reference to the print device, a request for status information to the print device is sent, and that the status information includes at least one of status of retrieval of the print content and status of printing the print content.

Manglapus discloses sending a request for status information to the print device, the status information including at least one of status of retrieval of the print content and status of printing the print content (Manglapus col. 9 lines 26-53, col. 1 lines 56- col. 2 line 18). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to send a request for status information to the print device, the status information including at least one of status of retrieval of the print content and status of printing the print content as taught by Manglapus. One of ordinary skill in the art would have been motivated to perform such a modification in order to provide the most commonly used protocol for status monitoring.

19. Claims 5, 18 and 37-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Larsson (International Publication No. WO 0142894) in view of Woo (U.S. Patent No. 6336074).

Larsson discloses a print device (380) comprising a print service (300b), the print device distinct from a content provider (200), and a wireless device (100) wirelessly communicating a reference identifying a location (document address) at which a print content of the content provider is located on a network (pg. 24 lines 19-30 and

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pg. 25 lines 17-20), wherein the reference causes the print device to retrieve the print content of the content provider from the network and to print the print content (pg. 25 lines 17-20).

Although, Larsson teaches implicitly communicating a reference (data sent from a portable device to the printer and comprising the reference identifying a location of a print content) to a print device comprising a print service, Larsson does not disclose adding a location of a print service. However, the location of a print service is the same as the location of the print device, and as a result the location of the print service would have to be added to the information sent to the print device in order for the delivery to reach the print device.

20. Larsson does not disclose that the print service is adapted to format the print content for printing.

Woo discloses a print service (print driver) adapted to format the print content (Woo, col. 3 lines 13-25). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to extend print service taught by Larsson to include formatting print content for printing as taught by Woo. One of ordinary skill in the art would have been motivated to perform such a modification in order to allow print device to print documents retrieved in variety of formats.

21. As per claim 37, the wireless devices disclosed by Larsson comprises a first communication interface (Larson, Fig. 6 object 118) that communicates a reference that identifies a location of a print content of the content provider to a print service (e.g. Fig. 1 object 210) wherein communicating the reference to the print service

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causes the print service to retrieve the print content of the content provider from a network and further causes the print service to transmit the print content of the content provider to the portable wireless device (Larsson pg. 22 lines 16-31, pg. 13 lines 15-22, pg. 21 lines 12-29). Also, Larson discloses a second communication interface (Larson, Fig. 6 object 116) that enable wireless communication between the portable wireless device and a print device (e.g. pg. 23 lines 3-17).

22. As per claim 39, in pg. 14 lines 5-24 and pg. 21 lines 12-27 Larsson discloses that the second is communication interface is adapted to cause the second communication interface to transmit the print content to the print device for printing.

23. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Larsson (International Publication No. WO 0142894) in view of Woo (U.S. Patent No. 6336074) and further in view of Hicks (U.S. Patent No. 7086001).

Larsson in view of Woo discloses communicating a reference to a print device and adding the information to the reference, as discussed above.

24. Larsson in view of Woo do not disclose that the information added comprises billing information.

Hicks discloses adding billing information to information sent to a print device (Hicks, col. 4 lines 22-29).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to add billing information to the information sent to a print device as disclosed by Hicks. One of ordinary skill in the art would have been motivated to

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perform such a modification in order to determine print information for billing purposes (Hicks, col. 2 lines 35-39).

25. Claims 10-12 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Larsson (International Publication No. WO 0142894) in view of Woo (U.S. Patent No. 6336074) and further in view of DeBry (U.S. Patent No. 6385728). Larsson in view of Woo discloses wirelessly communicating a reference to a print device as discussed above.

26. As per claims 11 and 42, Larsson in view of Woo does not explicitly disclose wirelessly communicating a security access code, wherein the security access code enables usage of the print device, enables access to the print content. DeBry teaches discloses communicating a security access code (a digital signature) to the print device wherein the access code enables access to the print content (col. 7 line 15 – col. 8 line 36).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to communicating a security access code, wherein the security access code enables usage of the print device, enables access to the print content as disclosed by DeBry. One of ordinary skill in the art would have been motivated to perform such a modification in order to pass authorization to a printer to retrieve and print a file (DeBry, col. 5 lines 34-36).

As per claim 10, DeBry's invention aims to ensure that only authorized access to the print content results in the content being sent to the printer for the printing (DeBry, col. 5 lines 11-19). Thus, the access code inherently enables the specific usage of

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the print device: printing of the requested document. Additionally, DeBry discloses a security access code (encrypted message) in response to a security challenge received from the print device used to restrict access to the print device (Fig. 4 and col. 9 lines 5-27).

27. As per claim 12, Larsson in view of Woo does not explicitly disclose wirelessly communicating the security access code in response to a security challenge received from the print device.

DeBry discloses a security access code (encrypted message) in response to a security challenge received from the print device used to restrict access to the print device (Fig. 4 and col. 9 lines 5-27).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to communicating the security access code in response to a security challenge received from the print device as disclosed by DeBry. One of ordinary skill in the art would have been motivated to perform such a modification in order to ensure the validity of the requester.

28. Claims 22 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Larsson (International Publication No. WO 0142894) in view of Woo (U.S. Patent No. 6336074) and further in view of Ferlitsch (U.S. Pub. No. 20020114004).

Larsson in view Woo of disclose wirelessly communicating the reference to a print device as discussed above.

29. Larsson in view Woo do not disclose that after communicating the reference to the print device, a request for status information to the print device is sent, and that the

status information includes at least one of status of retrieval of the print content and status of printing the print content.

Ferlitsch discloses sending a request for status information to the print device, the status information including at least one of status of retrieval of the print content and status of printing the print content (Ferlitsch [79-80]). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to send a request for status information to the print device, the status information including at least one of status of retrieval of the print content and status of printing the print content as taught by Ferlitsch. One of ordinary skill in the art would have been motivated to perform such a modification in order to determine the progress of the print job.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Poltorak whose telephone number is (571) 272-3840. The examiner can normally be reached Monday through Thursday from 9:00 a.m. to 4:00 p.m. and alternate Fridays from 9:00 a.m. to 3:30 p.m.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Zand can be reached on (571) 272-3811. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



1/23/07


KAMBIZ ZAND
PRIMARY EXAMINER